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### **REMARKS**

Claims 35, 37, 38, 40-42, 47, and 59-66 are currently pending in the application. Claims 35, 37, 38, 40-42, 60, 61 and 64 are amended. Claim 66 is added. Newly added claim 66 finds support throughout the specification (particularly at pages 6-8) and in the claims as originally filed. No new matter is added.

#### **Rejection of claims 35, 37-38, 40-42, 47, 59, and 60 Under 35 U.S.C. §112, first paragraph**

The Examiner has rejected claims 35, 37-38, 40-42, 47, 59, and 60 Under 35 U.S.C. §112, first paragraph for lack of enablement. The Examiner asserts that while the claims are enabled for a nucleic acid encoding an amino acid of SEQ ID NO: 2-4, or a nucleic acid consisting of the sequence as set forth in SEQ ID NO: 1, they are not enabled for a nucleic acid which *comprises* nucleic acid sequence which encode SEQ ID NO: 2-4 or a nucleic acid which *comprises* SEQ ID NO: 1. The Examiner also rejected claims 35, 37, 38, 40-42, 47, 59, and 60 under 35 U.S.C. §112, first paragraph for lack of written description. The Examiner asserts that the claims are drawn to a genus, and that the specification does not sufficiently describe members of the genus in a way to reasonably convey to one of skill in the art that Applicants were in possession of the claimed invention.

Applicants respectfully traverse the rejection. In order to advance the prosecution of the instant application, however, Applicants have amended claims 35, 37, 38, 40-42, and 60 to recite “consisting essentially of” rather than “comprising”. Applicants submit that this amendment should obviate the Examiner’s rejection and therefore request that the rejection be reconsidered and withdrawn.

#### **Rejection of claims 35 and 37 under 35 U.S.C. §102(b)(e)**

The Examiner has rejected claims 35 and 37 under 35 U.S.C. §102(b) as being anticipated by the Stratagene Catalog (1991). The Stratagene Catalog teaches the Prime-it™

random primer labeling kit. The kit comprises “random 9-mer primers” for use in the generation of hybridization probes. The Examiner asserts that the random 9-mers are capable of hybridizing to all gene sequences and would thus meet the limitation of claims 35 and 37 in that the primers are isolated DNA which are complementary to a sequence as set forth in SEQ ID NO: 1. Applicants respectfully disagree.

The claims, as amended, recite an isolated polynucleotide consisting essentially of a nucleic acid sequence listed as SEQ ID NO: 1 or a complementary strand. The phrase “complementary strand” thus refers to a nucleic acid strand which is complementary to the sequence of SEQ ID NO: 1, not a fragment of SEQ ID NO: 1. The random 9-mers cited by the Examiner are not complementary strands of SEQ ID NO: 1, but are merely complementary fragments of SEQ ID NO: 1. Moreover, why stop at a 9-mer? Why not a 2-mer? By the Examiner’s rationale, strand of only two nucleic acid residues would be a complementary strand of SEQ ID NO: 1. Clearly, this is not what is understood in the art to be the meaning of a complementary strand. Therefore, given the 932 base sequence of SEQ ID NO: 1, Applicants submit that a 9 residue sequence does not constitute, and thus does not anticipate the complementary strand of the 932 base strand of SEQ ID NO: 1.

In addition, the teachings of the Stratagene Catalog do not amount to a teaching of a complementary sequence of SEQ ID NO: 1. No sequences are taught in the Stratagene catalog. The Examiner is assuming that the tube of random 9-mers provided in the Stratagene kit would contain a complementary sequence of SEQ ID NO: 1. Applicants submit that this assumption finds no support in the Stratagene Catalog. There is nothing in the description in the Stratagene Catalog which teaches that, of the 262,144 possible 9-mer sequences, the kit necessarily contains one which would be complementary to SEQ ID NO: 1. Therefore, Applicants submit that the Stratagene Catalog does not teach every element of the claim, and thus, does not anticipate the invention.

The Examiner has also rejected claim 60 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,837,809 (Grandy et al.). The Examiner asserts that Grandy et al. teach a ligand identical to that of SEQ ID NO: 2 recited in claim 60. The Examiner notes that Applicants

previously filed a Rule 132 Declaration to antedate Grandy et al. by establishing an earlier date of invention. The Examiner points out, however, that the declaration itself was insufficient to overcome the rejection because under 37 C.F.R. 1.608, if the effective filing date of the application is three months or less after the effective filing date of the prior art then Applicants must submit a statement alleging that there is a basis upon which the Applicants are entitled to the earlier date of invention. Such a statement was not previously submitted.

Accordingly, Applicants submit herewith a statement under 37 C.F.R. §1.608 which alleges that there is a basis upon which Applicants are entitled to a judgment relative to Grandy et al. In combination with the Rule 132 declaration and Applicants remarks previously filed, the presently filed statement under 37 C.F.R. §1.608 should be sufficient to overcome the Examiner's rejection of the claims under 102(e). Applicants accordingly request that the rejection be reconsidered and withdrawn.

**Rejection of Claims 40, 47, and 59 Under 35 U.S.C. §103(a)**


The Examiner has rejected claims 40, 47, and 59 under 35 U.S.C. §103(a) as being obvious over Grandy et al. The Examiner asserts that it would have been obvious to one of skill in the art to make a nucleic acid encoding the peptide of SEQ ID NO: 2, despite the fact that Grandy et al., do not expressly teach such a nucleic acid molecule.

Applicants submit that, as described above in the response to the 102(e) rejection, they allege that by the Rule 132 declaration filed previously, Grandy et al. is not prior art against the present invention. That is, Applicants allege that they are able to antedate Grandy et al. and thus, the reference can not be used in the present rejection. Accordingly, Applicants request that the rejection be reconsidered and withdrawn.

Applicants submit that in view of the foregoing remarks, all issues relevant to patentability raised in the Office Action have been addressed. Applicants respectfully request the withdrawal of rejections over the claims of the present invention.

Respectfully submitted,

Date: March 24, 2004

  
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